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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,271	10/26/2000	Yoichiro Sako	6715/60007	2353

7590

03/22/2005

Jay H Maioli
CooPE & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,271

Applicant(s)

SAKO ET AL.

Examiner

Tongoc Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7-9, 11, 13-15, 18-20 and 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 7-9, 11, 13-15, 18-20, 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 12, 2004 has been entered.

Response to Arguments

2. Response to applicant's remark to U.S.C. 102 rejection:

In response to Applicant's remark that the amended "built-in" memory is not taught by Shear since Shear clearly discloses that it is a videocassette recorder that comprises the external apparatus and a videocassette recorder does not contain a built-in memory means. Examiner notes that Shear's disclosure does not limit the external apparatus to a videocassette recorder, rather Shear teaches that analog devices such as videocassette recorder can be permitted to copy but not the digital device because analog devices are incapable of making multigenerational copies without significantly loss in quality whereas digital devices can make unlimited number of copies without quality loss [0082]. Shear also discloses receiving devices can be different types or different classes of devices (e.g. computer 0032) and different rules may be applied to receiving contents depending on the types or classes of the devices. (e.g. no copy, 0054). Therefore, it implies that means to detect the capability of the system such as

built-in memory to make copy would be inherently required in order to prevent the device to make copy.

As for claim 3, Applicant contends that Shear is silent concerning controlling the transmission of output data to the external apparatus in accordance with the version of the external apparatus as recited in claim 3. Shear teaches "the device may also put a unique identifier of a receiving device and/or class of devices in the same secure container...the copy may be playable only on the intended receiving device, class(es) of devices...according to these and/or other variables" (0056). Therefore, since different version of devices may vary in different functions, without the identified version (or classes of devices), the intended receiving device would not have been able to identified.

As for claim 4, Applicant contends that Shear is silent that the transmission of the output data to the external apparatus is controlled accordance to whether the external apparatus is a copyright related apparatus. Shear teaches "the receiving device, upon detecting the digital property is indeed a copy, can, for example, be proprogramed not to make any additional copyies that can be played on a consumer device and/or other class(es) of device (0057).

As for claim 7, Shear contends that Shear does not teach controlling transmission of the output data in accordance with the amount of output data that is to be transmitted to the external apparatus. The limitation is broadly interpreted as controlling the output of the data in according to what is ordered (pay per view). Shear teaches "...they may charge for the use of a portion... of the distributed..." ([0092]) met

the limitation of "controlling the output database upon detecting the amount of output data to be transmitted" as cited in claim 7.

As for claim 8, Applicant contends that Shear is completely silent concerning determining whether the data is being output at a specific speed as recited in claim 8. Shear teaches "...high speed memory mapped digital serial bus that is self-configuring..." met the limitation of "controlling the output data in accordance with the speed at which the output data has been reproduced". The claim limitation can broadly interpreted to be synchronizing the output transmission in accordance with the speed at which the output data is to be transmitted to the external apparatus.

As for claim 9, Shear teaches "...different controls may apply to different equipment and/or classes of equipment such as player and/or computer equipment depending on the capabilities of the particular platform and/or class of platform" ([00220]) met the limitation of "the output data is controlled based on the recording the type of recording medium" as recites in claim 9.

As for claim 11, Shear teaches "enables DVD drive ...where they may charge for the use of a portion..." met the limitation of "charging a fee in accordance with the determination of the kind of external-apparatus...".

As for claim 23, Shear teaches "if the request operation is to release content... the control may prevent platform from releasing content except to certain types of output devices..." met the limitation of "the use of a plurality of different interfaces and controlling the output based upon the detected kinds of the various interfaces".

As for claims 41-44, rejected under U.S.C. 103, for the reason stated above.

Examiner maintains the rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-4, 7-9, 11, 13-15, 18-20 and 23-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Shear (US Patent Application Publication US200110042043).

In respect to claim 2, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;
External-apparatus identifying) means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus and control means for controlling transmission of output data to an external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means, (Shear, [0282]) wherein the external-apparatus identifying means determines whether the external apparatus is a data storage apparatus that has a build-in memory means for storing data input through

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the interface, and the control means stops the transmission of output data to the external apparatus when the external-apparatus identifying means determines that the external apparatus is the data storage apparatus having the built-in memory (see Shear, [0030-0031, 0054, 0282, 0168]).

In respect to claim 3, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;
External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and control means for controlling transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means (see Shear, [0282, 0056], wherein the external-apparatus identifying means determines a version of the external apparatus, and the control means controls the transmission of output data to the external apparatus through the interface, in accordance with the version of the external apparatus (see Shear [0070, 0056])).

In respect to claim 4, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;
External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus, and control means for controlling transmission of output data to the external

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apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means, (see Shear, [0282]), wherein the external-apparatus; identifying means determines whether the external apparatus is a copyright-related apparatus, and the control means controls the transmission of output data to the external apparatus through the interface, in accordance with result of determination (see Shear, [0054, 0057]).

In respect to claim 7, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;
External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and

Control means for controlling transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means (see Shear 0282), wherein the control means controls the transmission of output data to the external apparatus through the interface, in accordance with an amount of the output data to be transmitted to the external apparatus (see Shear, [0092]).

In respect to claim 8, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;

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External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and

Control means for controlling transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means (see Shear, [02821],

wherein the control means controls the transmission of output data to the external apparatus through the interface, in accordance with a speed at which the output data is to be transmitted to the; external apparatus (see Shear, [0179]).

In respect to claim 9, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;
External-apparatus identifying means for determining a type of an external apparatus connected to the interface; and outputting data representing the type of the external apparatus; and control means for controlling transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means (see Shear, f 2821)¹

wherein data-reproducing means is provided for reproducing the output data from a recording medium, and the control means controls the transmission of output data to the external apparatus through the interface, in accordance with the recording medium (see Shear, [0220]).

In respect to claim 11, Shear discloses the data transmitting apparatus,

comprising:

An interface that can be connected to various external apparatuses;
External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and control means for controlling transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means (see Shear, 01 282)], further comprising- fee-charging means [is provided] for charging a fee in accordance with the transmission of output data through the interface, and the control means controls a fee-charging process performed by the fee-charging means, in accordance with the result of determination made by the external-apparatus identifying means of the type of the external apparatus (see Shear, [0092]).

In respect to claims 13-15 and 18-20, the claims limitations are method claims that are substantially similar to apparatus claims 3-4 and 7-9 and 11. Therefore, claims 13-15, and 18-20 are rejected based on the similar rationale.

In respect to claim 23, Shear discloses a data apparatus comprising:
a plurality of interfaces of different types; and control means for controlling transmission of output data through the plurality of interfaces in accordance with the types of interfaces (see Shear, [0039, 0282 and 0220]).

In respect to claims 24-30, the claim limitations are substantially similar to claims 7-11. Therefore, claims 24-30 are rejected based on the similar rationale. In respect to claims 31-40, the claim limitations are method claims that are substantially similar to

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apparatus claim 23-30. Therefore claims 31-40 are rejected based on the similar rationale.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al. (U.S. Patent Application Publication, US 200110042043) in view of Ottesen et al. (U.S. Patent No. 5,654,747).

In respect to claim 41, Shear discloses a data transmitting method for use in a data transmitting apparatus for transmitting, through an interface, output data reproduced from a recording medium, the method comprising: a fee-charging control step of performing a fee-charging process in accordance with the transmission of output data through the interface and controlling the transmission of output data (see Shear [0092]). Shear does not explicitly disclose wherein the fee-charging control step is to perform the fee-charging process by "updating", in accordance with the fee to be charged, data recorded on the recording medium and corresponding to a sum of fees that can be charged for the recording medium, and to stop the transmission of output

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data through the interface when the data corresponding to the sum of fees reaches or exceeds a predetermined value. However, Ottensen discloses communicating a billing signal to the information network in response to each presentation of a downloaded source program (updating). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Ottensen by updating the billing information as information is downloaded from source with Shear's teaching of billing for the fee charging control system in order to allow for automatic billing for each program presentation to the customer's account (see Ottensen, col. 8, lines 5-9). Furthermore, Shear does not explicitly disclose stop the transmission of output data when the data corresponding to the sum of fees reaches or exceeds a predetermined value. However, Official Notice is taken that pay for view with predetermined selection of program by subscriber is old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate stopping output when data corresponding to the sum of fees reaches as in preselect pay for view program with Shear's fee charging control system in order to output program according to subscriber's predetermined on selected program they are interested to view.

In respect to claims 42-44, the claim limitations are substantially similar to claim 41. Therefore, claims 42-44 are rejected based on the similar rationale.

Conclusion


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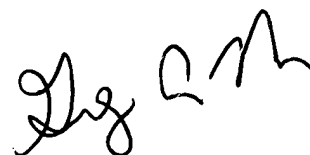
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
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March 14, 2005



GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER